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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,132	03/30/2001	Balaji Parthasarathy	219.39505X00-P10751	4226

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EXAMINER

ELLIS, RICHARD L

ART UNIT	PAPER NUMBER
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2183

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/835,132

Applicant(s)

PARTHASARATHY ET AL.

Examiner

Richard Ellis

Art Unit

2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7, 13-18, 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1, 8-12, 19-23 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20041108</u>  | 6) <input type="checkbox"/> Other: _____                                    |

1. Claims 1-20 remain for examination. Claims 21-26 are newly presented for examination.
2. Applicants information disclosure citation filed November 8, 2004 appears to be incomplete. The Patent Office received to pages of form 1449 citing fourteen (14) documents. However, page 1 is labeled "page 1 of 3" and page 2 is labeled "page 2 of 3" and the Patent Office did not receive page 3. The fourteen cited documents were provided, and accordingly, have been considered.

Additionally, the text of the citation for documents 8 and 12-14 on page 2 of the received IDS has been cut off by the lines of the table. Applicant is required to resubmit a new form 1449 which lists in full the complete text of at least items 8 and 12-14 of page 2 of the form 1449.

3. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.
4. Claims 11 and 20 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number "May 13, 2004", mailed May 19, 2004.
6. New claims 23 and 26 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the same reasons as the rejection of claims 11 and 20, supra.
7. Claims 1, 8-12, and 19-20 are rejected under 35 USC 102(b) as being clearly anticipated by Gaddis et al., U.S. Patent 5,457,681.

Gaddis et al. was cited as a prior art reference in paper number "May 13, 2004", mailed May 19, 2004.

8. The rejections are respectfully maintained and incorporated by reference as set forth in the last office action, paper number "May 13, 2004", mailed May 19, 2004.
9. New claims 21-23 are rejected under 35 USC 102(b) as being clearly anticipated by Gaddis et al., U.S. Patent 5,457,681, as applied to claims 1, 8-12, and 19-20, supra.
10. Applicant's arguments filed November 4, 2004, paper number 20041108, have been fully considered but they are not deemed to be persuasive.
11. In the remarks, applicant argues in substance:
  - 11.1. That: "The Examiner has indicated that the use of the trademark/tradename Infiniband in these claims renders the claims indefinite. The Applicants respectfully submit that the use of this term in claims 11 and 20 is to limit the scope of the claimed subject matter to indicate that it is compliant with the Infiniband specification. The claim language is not attempting to recite subject matter of a product that is identified with an "Infiniband" trademark. It is merely definitely indicating subject matter that is compliant with the Infiniband specification. This is a clear definition of the claimed subject matter since one of ordinary skill in the art would be able to determine what is compliant with or not compliant with the Infiniband specification."

This is not found persuasive because a trademark/tradename is incapable of limiting the scope of a claim. Applicant's attention is directed to MPEP § 2173.05(u) where it is stated in pertinent part:

"It is important to recognize that a trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. See definitions of trademark and trade name in MPEP ' 608.01(v). A list of some trademarks is found in Appendix I."

Further, MPEP 2173.05(u) states:

"If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name."

Applicant's own arguments admit that the trademark is used in the claim as a limitation to identify or describe a particular material or product, and accordingly, by applicant's own

admission, the usage of the trademark Infiniband in the claims is an improper use of that trademark. Applicant is also reminded that improper use of the trademark Infiniband could subject applicant to legal liability by dilution and/or destruction of the value of that trademark to it's rightful owner. Additionally, such misuse could subject applicant's attorney to a malpractice charge for intentional misuse, dilution, and/or destruction of the value of that trademark to it's rightful owner by his improper use of that trademark as a claim limitation to identify a particular material or product.

11.2. That: "the Gaddis et al. patent does not disclose or even suggest at least the claimed feature of a Micro-Engine (ME) implemented with a pipelined execution architecture to handle one or more ME instructions and/or more tasks to process data for data transfers. The Examiner has relied upon column 5, lines 5-9 of the Gaddis et al. patent to disclose this feature. However, this section of the Gaddis et al. patent merely discloses off the shelf components that may be included in the described system. Gaddis et al. does not disclose or suggest a pipelined execution architecture that handles one or more ME instructions and/or more tasks to process data for data transfers."

This is not found persuasive because applicant's attention is drawn again to col. 5 lines 5-9 to Gaddis et al. At this section Gaddis et al. discloses at least two conventional CPU's that were envisioned to be used within the system, the Intel 80486 and Motorola 68030 CPU's. These CPU's are for the "CONTROL MICROPROCESSOR" which is what is equivalent to applicant's label "Micro-Engine" within his claims, and as disclosed by Gaddis et al. do indeed handle tasks to process data for data transfers. Additionally, the two CPU's that Gaddis et al. discloses (Intel 80486, Motorola 68030) also both happen to be pipelined CPU's as well. Therefore, Gaddis et al. has indicated a "pipelined execution architecture to handle one or more ME instructions" by the simple fact of indicating that he is using a conventional pipelined CPU as the "CONTROL MICROPROCESSOR" within his system.

12. Claims 2-7, 13-18, 24-26 are allowable over the prior art of record. However, claim 26 is not allowable in total due to the improper use of the trademark "Infiniband" within that claim.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a). The practice of automatically extending the

shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

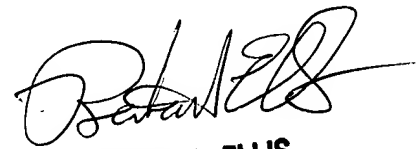
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Richard Ellis whose telephone number is (571) 272-4165. The Examiner can normally be reached on Monday through Thursday from 7am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eddie Chan, can be reached on (571) 272-4162. The fax phone number for the USPTO is: (703)872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Richard Ellis  
January 11, 2005



RICHARD L. ELLIS  
PRIMARY EXAMINER